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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,954	03/30/2001	David W. Cannell	05725.0637-00	7371

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EXAMINER

SHARAREH, SHAHNAMEH J

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/820,954	<b>Applicant(s)</b> CANNELL ET AL.
	<b>Examiner</b> Shahnam Sharareh	<b>Art Unit</b> 1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-37, 39-57 and 59-79 is/are pending in the application.
- 4a) Of the above claim(s) 1-37, 39-57 and 59-77 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 78 and 79 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

Applicant's election with traverse of the species directed to claims 78-79 in the reply filed on April 23, 2004 is acknowledged. The traversal is on the ground(s) that the search and examination of the entire application can be done without serious burden. This is not found persuasive because as recited in the species requirement of March 23, 2004, claims ~~37~~, 39, 41, 43, 47-49, 60-63, 66-67 are drawn to compositions that does not comprise glucosamine. However, claims 78-79 are drawn to compositions that comprise glucosamine. Compositions containing glucosamine are classified in Class 514, subclass 62. On the other hand, the claimed compositions excluding glucosamine may be classified in Class 514, subclass 42. Different classification of an invention is *prima facie* evidence of undue burden of search and examination. See MPEP§ 803.

Moreover, Applicant has not submitted evidence or identify any evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. Thus, the species requirement is proper.

Claims 1-37, 39-57, 59-79 are pending in this application. Claims 1-36, 40, 42, 44-46, 50-57, 59, 64-65 were previously withdrawn pursuant to the Restriction requirement set forth in February 22, 2002 as being directed to the non-elected invention and/or non-elected species. Claims ~~37~~, 39, 41, 43, 47-49, 60-63, 66-77 are withdrawn as being directed to non-elected species. claims 78-79 are herein under considerations for their merits.

Amendment filed on February 9, 2004 has been entered.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 78 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 78 recites the limitation "said at least one compound" in line 9 of the claims. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 78-79 are rejected under 35 U.S.C. 102(b) as being anticipated by Drizen et al US Patent 5,897,880.

The instant claims are directed to compositions comprising at least one glucosamine and at least one additional aminoglycan other than glucosamine comprising at least one C5-C7 saccharide unit substituted with at least one amino group.

Riordan discloses compositions comprising N-acetyl-D-glucosamine and hyaluronic acid. (see abstract; col 7, lines 20-55; claims 13, 20-21). Hyaluronic

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acid which is a aminosaccharide comprising glucosamine and gluconic acid meets the instant component of a different aminosugar that is different from glucosamine and comprise at least one C5-C7 saccharides unit with at least one amino group. Further, the amounts of aminosaccharides taught by Riordan overlaps with those taught in the instant specification, therefore, Riordan's compositions inherently is able to protect at least one keratinous fiber against extrinsic damage.

### ***Conclusion***

No claims are allowed. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shahnam Sharareh whose telephone number is 571-272-0630. The examiner can normally be reached on 8:30 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, PhD can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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